

REMARKS

This Amendment is responsive to the Office Action dated September 2, 2008. Applicant has amended claims 1-5, 9, 10 and 14-16; canceled claims 12 and 13; and added claim 17.

Claims 1-11 and 14-17 are pending.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-16 under 35 U.S.C. 102(e) as being anticipated by Haller et al. (US 2002/0013613), hereafter referred to as “Haller.” Applicant respectfully traverses the rejection to the extent such rejection may be considered applicable to the amended claims. Haller fails to disclose each and every feature of the inventions defined by Applicant’s claims as amended, as required by 35 U.S.C. 102(e). Furthermore, there is no rational reason for modification of the Haller system to include such features.

Independent Claim 1

Amended claim 1 requires receiving a pre-determined monetary amount as a premium from an operator of an external defibrillator, and maintaining a contractual relationship with the operator for a period of time in exchange for the predetermined monetary amount. The Examiner’s argument regarding these limitations of claim 1 is error because it appears to ignore the requirement that contractual relationship is in exchange for the received predetermined monetary amount.

In particular, the Examiner argued that paragraph 178 of Haller discloses receiving a predetermined monetary amount, and paragraph 191 discloses maintaining a contractual relationship. Paragraph 178 of Haller describes use of prepaid magnetic cards by a patient to pay for services, such as checking the state of the battery of an IMD, or provision of a tachycardia intervention by the IMD. Paragraph 191 of Haller describes “another method” whereby a patient leases or rents a module 100 or PDA 110, rather than buy them, because their prognosis is such that they would not be reimbursed, e.g., by insurance, for the full cost of such devices. These teachings of Haller are unrelated. Haller does not suggest that the prepaid card of paragraph 178 may be used to make the rental or lease payments of paragraph 191, or, payments in exchange for any contractual relationship. Furthermore, Haller does not suggest that the prepaid card of

paragraph 178 may be used to provide a predetermined monetary amount as a premium, as required by claim 1, as amended.

Amended claim 1 further requires the contractual relationship maintained according to the method includes a requirement to reimburse an operator of an external defibrillator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of another party. The Examiner admitted that Haller does not disclose this requirement. However, the Examiner argued that this requirement is not entitled to patentable weight because it is non-functional descriptive material.

Applicant respectfully disagrees with the Examiner's characterization of this limitation as non-functional descriptive material. Claim 1 does not even recite descriptive material. Claim 1 does not recite music, literature, art, or a mere arrangement or compilation of facts or data. Claim 1 does not recite a paper with text appearing thereon. Instead, claim 1 recites maintaining a contractual relationship in exchange for a predetermined monetary amount. A relationship is not akin to music or mere data, and is not descriptive material.

Furthermore, the limitation that the relationship includes a requirement to reimburse an operator of an external defibrillator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of another party clearly limits and therefore changes the recited relationship, and thus the maintaining step and the claim as a whole. Claim 1 does not cover any method in which a contractual relationship is maintained, but rather those in which a contractual relationship that includes a requirement to reimburse an operator of an external defibrillator for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of another is maintained.

At least because this limitation of claim 1 is not non-functional descriptive material, and is admittedly not disclosed or suggested by Haller, the rejection of claim 1 should be withdrawn.

Additionally, independent claim 1 has been amended to recite determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time. This newly-added limitation of claim 1 is not disclosed or suggested by Haller. Therefore, for at least this additional reason, the rejection of claim 1 should be withdrawn.

Furthermore, amended claim 1 positively recites reimbursing the operator in accordance with the contractual relationship in response to the determination that the external defibrillator was used for the benefit of the other party for at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party. The Examiner argued that paragraphs 188 and 189 of Haller disclose this limitation. These paragraphs of Haller do mention reimbursement generally. However, these paragraphs do not suggest reimbursing in response to a determination that a defibrillator was used, as required by claim 1. Directly contrary to this requirement, these paragraphs suggest receiving reimbursement operation prior to provision of a therapy or other remedial action.

Also, Haller is directed towards techniques for managing data and services to a patient with an implanted medical device. Applicant has previously pointed out to the Examiner that Applicant's claimed method requires reimbursing an operator of an external defibrillator for expenses associated with use of the external defibrillator to treat another party, i.e., other than the operator. The Examiner has admitted that Haller fails to teach or suggest these requirements of independent claim 1.

Nevertheless, the Examiner argued that the recitation of an external defibrillator is merely a recitation of intended use that must result in a *structural* difference to patentably distinguish claim 1 from Haller. Applicant respectfully suggests that the Examiner is misapplying intended use to claim 1. Claim 1 recites a method. Therefore, structural differences are irrelevant to the analysis of the patentability of claim 1. The method of claim 1 requires, *inter alia*, determining that the external defibrillator was used for the benefit of another party during the period of time. This and other limitations reciting an external defibrillator used for another party, i.e., other than the reimbursed operator, cannot be dismissed as intended use, and must be given patentable weight. Furthermore, these limitations are not disclosed or suggested by Haller, as admitted by the Examiner.

The Examiner also argued that it would have been obvious to use the methods of Haller for an external defibrillator because the Haller system is designed to be used for a variety of products, and that it would have been obvious to use the defibrillator of Haller for the purpose of assisting another party undergoing a medical emergency.

Initially, Applicant notes that the Examiner has only rejected the claims under section 102, and is confused by the Examiner's statements regarding obviousness. Applicant respectfully requests that, if the Examiner believes an obviousness rejection is warranted, the Examiner formally reject the claims under section 103. Furthermore, with respect to the Examiner's latter obviousness statement, Applicant respectfully suggests that a person of ordinary skill in the art would not have considered it obvious to use a defibrillator implanted in a patient, as taught by Haller, to assist another party undergoing an emergency, as suggested by the Examiner. With respect to the former obviousness statement, Applicant respectfully disagrees that the Haller system is designed to be used for a variety of products. Haller is specifically directed to addressing issues associated with remote programming of an implantable medical device, as indicated throughout Haller.

For at least the above reasons, Haller does not disclose all features of Applicant's amended independent claim 1, as required for a rejection under section 102. For at least this reason, the rejection of claims 1-11 and 14 should be withdrawn.

Independent Claims 15 and 16

Independent claims 15 and 16, as amended, recite limitations similar to those of independent claim 1, as amended. For at least the reasons discussed above with respect to claim 1, Haller does not disclose all features of Applicant's amended independent claims 15 and 16, as required for a rejection under section 102, and the rejection of these claims should be withdrawn.

Dependent Claims

Dependent claims 2-11 and 14 are not anticipated by Haller, at least by virtue of their dependency on independent claim 1. Furthermore, the dependent claims recite features not disclosed or suggested by Haller.

For example, with respect to amended claim 4. Haller does not disclose or suggest receiving the pre-determined monetary amount upon purchase of the defibrillator by the operator. The Examiner argued that receiving a service and providing a change for the service as discussed at paragraph 185 of Haller are the same as this requirement. This is plainly incorrect, as paragraph 185 has nothing to do with purchasing a defibrillator, and therefore cannot be the same as receiving the pre-determined monetary amount upon purchase of the defibrillator by the operator.

New Claims:

Applicant has added claim 17 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claim. No new matter has been added by claim 17.

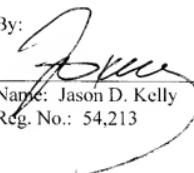
CONCLUSION

Claims 1-17 in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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